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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/101,864	07/21/98	CAVANAGH	M 20253-60398
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QM11/0308

EXAMINER

FOSTER, J

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

03/08/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/101,864**

Applicant(s)  
**Cavanagh**

Examiner  
**J. Foster**

Group Art Unit  
**3728**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 16 is/are allowed.

☒ Claim(s) 1-11, 13-15, 17, and 18 is/are rejected.

☒ Claim(s) 12 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claim 16 is allowable over the prior art.

2. The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it does not support an embodiment which includes both a semi-circular recess (Figs. 3,3A) and a suture recess (Figs 4,4A) as set forth in claim 14.

3. Claim 14 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

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4. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although claim 18 is a process claim, it fails to include~~s~~ any positively recited steps (e.g. "transferring ..." or "placing ..."). In addition, the present tense of the verbs (e.g. "places") in the claim make it unclear whether the action (e.g. placing) is positively recited or intended use.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 6, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Haaser (3,738,251). In the reference of Haaser, the basin 13 may be considered to define a recess, and the drain boards 11 may be considered to define inclined guide means. Although intended for photographic print developing, the recess 13 is capable of receiving a sharp surgical instrument/scalpel sized to be received therein, to the extent claimed by Applicant in since Applicant does not positively recite the instrument or steps in the claims, this

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capability of the recess of Haaser meets what Applicant has claimed in this regard.

The deepened and widened portion 15 of the recess defines an access means which would facilitate the user to grasp the handle of the scalpel.

7. Claims 1, 3, 4, 9, 10, 15 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Strauss (5,129,615). The holder 10 of Strauss includes a recess at 26 and an inclined guide means located at flange 32. Although intended for an umbrella, the recess 26 is capable of receiving a sharp surgical instrument/scalpel sized to be received therein, to the extent claimed by Applicant. Since Applicant does not positively recite the instrument or the steps in the claims, this capability of the recess of Haaser meets what Applicant has claimed in this regard. Arms 14,16 constitute handle means since they can be gripped by a person.

8. Claims 1-3, 7, 8, 13-15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (5,368,580). In the reference of Suzuki, a recess is provided at 13. Inclined guide means are shown in Figures 1, 2 3a, 3b, and 5 as being located at the mouth of the recess 13. The recess 13 widens just below the opening thereof and therefore provides barrier means. The holder of Suzuki is for holding a sharp surgical instrument, such as a syringe needle. However, the devices is capable of holding a thin scalpel.

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Regarding Applicant's claims 13 and 14, the recess 13 of Suzuki may be constitute a needle recesses at one end and a suture recess at the opposite end, insofar as Applicant has claimed.

Regarding claim 18, the device of Suzuki is capable of being used in the manner of intended use claimed by Applicant.

9. Claims 1, 2, 7, 8, 11, 15 and 18 rejected under 35 U.S.C. 102(b) as being anticipated by Kiyoshi et al (5,348,152). In the reference of Kiyoshi et al, recesses are provided by grooves 15, and inclined guide means are provided at the top of the sidewalls 3. Elements 5 define barrier means.

10. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. For contacting the PTO by phone, the following contact numbers may be used:

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February 22, 1999